

REMARKS**Summary of the Office Action**

Claims 1, 3, 6 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,903,705 to Yonemitsu et al. (“Yonemitsu”) in view of U.S. Patent No. 5,813,010 to Kurano et al. (“Kurano”), and further in view of U.S. Patent No. 5,608,534 to Park et al. (“Park”).

All Claims Define Allowable Subject Matter

Applicant respectfully traverses the rejection under 35 U.S.C. § 103(a), of claims 1, 3, 6 and 9, by Yonemitsu in view of Kurano and further in view of Park.

Claim 1 recites a recording medium reproduction apparatus for reproducing a DVD recording medium in which recorded data and table of contents data including recording medium side reproduction restriction information is recorded. The recording medium side reproduction restriction information is a region code. The apparatus includes apparatus side reproduction restriction information. The apparatus includes control means which outputs and displays the recording medium side reproduction restriction information when reproduction is stopped based on a comparison of the apparatus side reproduction restriction information with the recording medium side reproduction restriction information. Support for these features is provided at, for example, paragraphs 0019, 0034 and 0042 of Applicant’s specification as originally filed.

Therefore, a user can understand at a glance the reason why reproduction of the DVD is stopped. A user will know that the reproduction apparatus is not the reason why reproduction of the DVD is stopped, and that reproduction is stopped because the DVD recording medium

includes a region code that is not compatible with the reproduction apparatus. Moreover, a user will know at a glance the specific region code of the DVD recording medium, and not merely that reproduction is stopped because of a region code incompatibility.

The user's understanding at a glance can be very convenient, for example, when there is no description relating to the recording medium side reproduction restriction information on the DVD recording medium or the package of the DVD recording medium. As described at paragraphs 0006-0013 of Applicant's specification, there are cases where a region number display mark for managing a reproducible region corresponding to a region code of a DVD is not described on a package for the DVD. Further, there are cases where a region number display mark is not described on a DVD within a package. Furthermore, there are cases where a proper DVD is not housed within a package. That is, a region code of the DVD within the package does not correspond to a region number display mark of the package.

When reproducing an improper DVD in a conventional DVD reproduction apparatus and the user does not know that the DVD is improper, there arises the following problems.

In a conventional DVD reproduction apparatus, when an improper DVD is attempted to be reproduced, although an error indication is displayed on a TV receiver, the region code of the DVD is not displayed. Thus, the user can not know or understand the reason why the DVD is not reproduced merely from seeing the error indication displayed on the TV receiver.

Further, when a region number display mark is not described on both an improper DVD and the package thereof, a user can not know the region code of the improper DVD.

In the case where a region number display mark is not described on a DVD even if the region number display mark is described on the package of the DVD, a user also can not know

the region code of the improper DVD when the user loses the package.

Furthermore, even if a package is not lost, when a region number display mark is described on the package of a DVD but not described on the DVD, and a proper DVD is not housed within the package, a user also can not know the region code of the improper DVD.

Moreover, in the case where a proper DVD is not housed within the package and a region number display mark is described on each of a DVD and the package thereof, the region number display mark on the DVD may be correct if the region number display mark of the DVD does not correspond to the player region code of a DVD reproduction apparatus used for reproduction. However, in view of such a circumstance that the region number display mark of the package does not correspond to the region number display mark of the DVD housed within the package, it is doubtful whether the region number display mark of the DVD is correct. In other words, a user also can not know with certainty the region code of the improper DVD.

In the above cases, since the region code is unknown, even when an improper DVD is intended to be resold, such a DVD can not be easily resold in a proper region because a resalable region of the DVD is unknown.

The Office Action has pieced together three references (Yonemitsu, Kurano and Park) to teach or suggest the features recited in claim 1. However, Applicant submits that none of the three references solve or even recognize the above described problems of a conventional DVD reproduction apparatus. Applicant submits that there is no motivation to combine the references. MPEP § 2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)." MPEP §

2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" Applicant respectfully submits that the references do not provide such a suggestion or motivation.

Applicant respectfully submits that the only motivation to piece together the three references of the Office Action is found in the Applicant's own application. MPEP § 2141 instructs that "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." MPEP 2143 instructs that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ 1438 (Fed. Cir. 1991)." The Federal Circuit has clearly held that "the motivation to combine references cannot come from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993).

Thus, Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness and that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

The Office Action acknowledges that Yonemitsu does not teach or suggest the features of an OSD generating means and a displaying means, wherein when the determination means determines that the reproduction of the recorded data is not allowed, the control means generates a character signal related to an error signal and a recording medium side reproducing restriction information in the OSD generating means, and outputs and displays on the displaying means with superposing on a video signal. The Office Action relies on Park for a showing of an OSD generating means, a display means, and a character signal related to a recording medium side

reproducing restriction information, as recited in claim 1. Again, Applicant respectfully submits that there is no motivation to combine Park with Yonemitsu. Applicant submits that displaying the country codes, the broadcasting station names, the guide channel numbers and the channel positions on OSD unit 310, as described at col. 10, ll. 60-64, is quite different than displaying recording medium side reproduction restriction information as a region code.

As described at col. 1, ll. 8-12, and col. 2, ll. 49-51, Park is directed to a video cassette recorder for reservation-recording a desired broadcasting program. That is to say, a user may set the VCR of Park to record a desired broadcast channel at a desired time. An embodiment of the VCR of Park that is relied upon in the Office Action is described beginning at col. 8, line 53, and illustrated in Figs. 6-8. In the embodiment, there is provided a VCR having a G code input unit 210, first to fourth memories 230, 280, 290 and 300, a decoder 220, a controller 240, a tuner 250, a pilot signal detector 260, a recording section 270 and an OSD unit 310. The VCR is allegedly adapted to map channel positions according to different guide channel numbers by countries to perform the reservation-recording so that the VCR may readily be utilized in a region in which the frontiers of different countries are adjacent to one another and broadcasting signals of the different countries are received, such as, for example, in Europe. So Park merely shows a video cassette recorder for displaying a channel which is capable of being synchronized on an OSD.

Claim 3 recites a recording medium reproduction apparatus for reproducing a DVD recording medium in which recorded data and table of contents data including recording medium side reproduction restriction information is recorded. The recording medium side reproduction restriction information is a region code. The apparatus includes apparatus side reproduction restriction information. The apparatus includes a control member which outputs and displays the

recording medium side reproduction restriction information when reproduction is stopped based on a comparison of the apparatus side reproduction restriction information with the recording medium side reproduction restriction information. For the reasons described above with respect to claim 1, Applicant submits that there is no motivation to combine Yonemitsu, Kurano and Park. Accordingly, Applicant submits that claim 3 is patentable as well as claim 1.

Claim 6 depends from claim 1, and claim 9 depends from claim 3. The dependent claims recite the same combination of allowable features recited in the independent claims, as well as additional features that define over the prior art. Accordingly, it is requested that the rejection under 35 U.S.C. § 103(a), of claims 1, 3, 6 and 9 be withdrawn, and the claims allowed.

CONCLUSION

Applicant respectfully requests Reconsideration by the Examiner, placing all pending claims in condition for allowance. Applicant submits that the Request for Reconsideration does not raise new issues or necessitate additional search of the art by the Examiner.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite the prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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